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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/663,918	09/16/2003	Richard A. Wilsak	37,512	2288

7590 05/07/2009
BP America Inc.
Docket Clerk, BP Legal, M.C. 5East
4101 Winfield Road
Warrenville, IL 60555

EXAMINER

POPOVICS, ROBERT J

ART UNIT	PAPER NUMBER
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1797

MAIL DATE	DELIVERY MODE
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05/07/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/663,918

Applicant(s)

WILSAK ET AL.

Examiner

/Robert James Popovics/

Art Unit

1797

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 March 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 2, 5-41, 44, 45 and 48-52 is/are pending in the application.
- 4a) Of the above claim(s) 17-39 and 50-52 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 5-16, 40, 41, 44, 45, 48 and 49 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

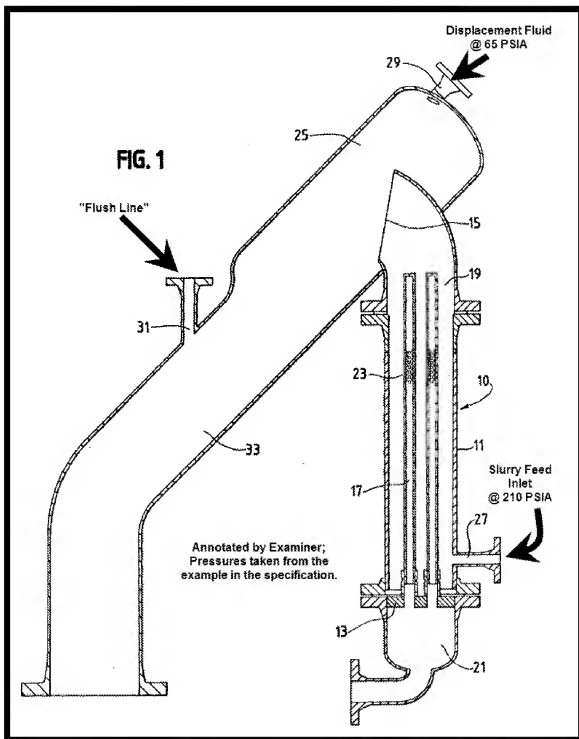
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Figure 1 Annotated in View of The Example



Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

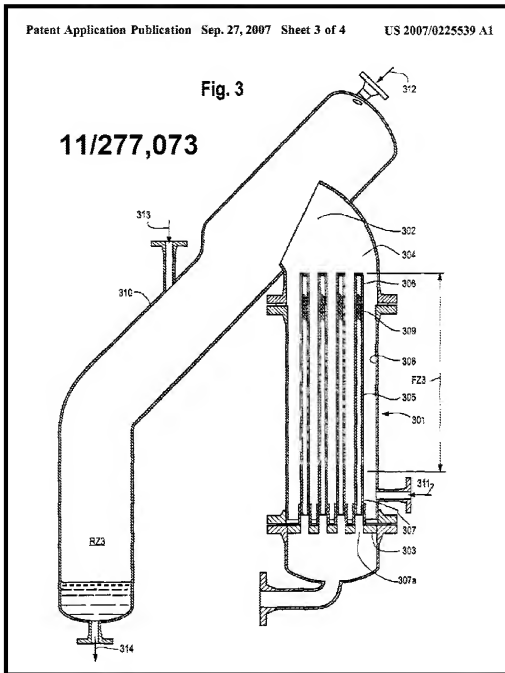
The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims **1,2,5-16,40,41,44,45,48 and 49** are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the **enablement** requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Applicant has failed to teach those skilled in the art how a displacement fluid entering through nozzle 29 would be caused to flow in a manner that would displace at least a portion of liquid from a slurry feed, i.e.:

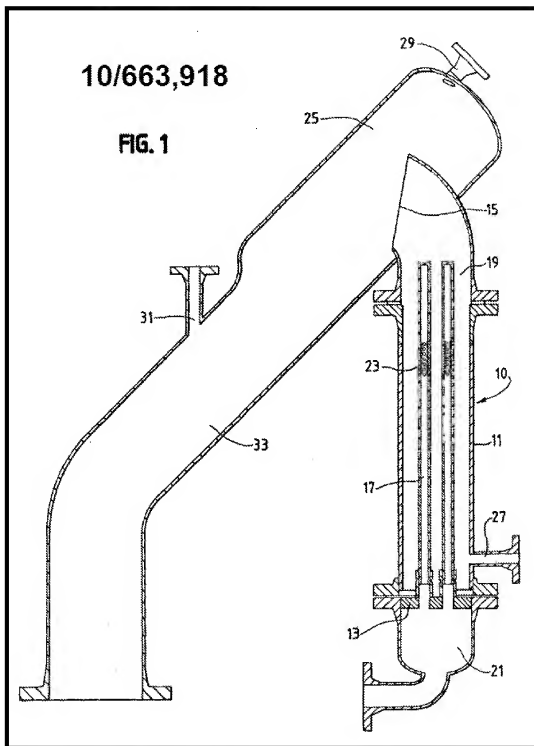
wherein the displacement fluid is insoluble in the slurry feed components and displaces at least a portion of the liquid from the slurry feed past the filter and into the lower concentration zone to produce a filtrate in the lower concentration zone.

In this regard, it is noted that the only apparatus disclosed to accomplish this step is Fig. 1, which discloses an open chute 33. As such, it is unclear how the above stated step would be accomplished. It is axiomatic that a fluid under pressure will follow the path of least resistance. Referring to Fig. 1, that would be chute 33.

Claims **1,2,5-16,40,41,44,45,48 and 49** are rejected under 35 U.S.C. 112, first paragraph, because the **best mode** contemplated by the inventor has not been disclosed. Evidence of concealment of the best mode is based upon **Figure 3 of US 2007/0225539 A1**.



Comparing Figure 3 of US 2007/0225539 A1 with Fig. 1 of the instant disclosure



it would appear that something is missing. Specifically, there is no means disclosed for controlling the pressure at the open end of chute 33.

Response to Arguments

Applicant's arguments filed **March 23, 2009** have been fully considered but they are not persuasive. Applicants have argued:

The Examiner is correct to assume the displacement fluid entering nozzle 29 proceeds towards chute 33. However, the displacement fluid also "initially enters the open end 15 of the cylinder [11]" during start-up. See specification, page 15, line 13.

Unfortunately, this argument is not commensurate with the scope of the claims, which where previously amended to specify that all steps took place simultaneously. When the process steps all take place simultaneously, there are no "initial" steps. Applicants later refer to the sole example in the case, when challenging the rejections made. After considering the pressures set forth in the sole example, it is unclear how any displacement fluid at 65 PSIA will simultaneously flow down filter column 10, when slurry at 210 PSIA is being introduced thereto via slurry feed inlet 27. Applicants trivialize the controls/valves necessary to practice the invention, citing to Hybritech. Unfortunately, the undersigned disagrees, considering those controls essential to the practice of the invention. Applicants' arguments, citing to the sole example, only serve to bring more questions to the surface. What would permit flow in a direction from a lower pressure (e.g., 65 PSIA) to a region of higher pressure (e.g., 210 PSIA)?

As for the best mode rejection, Applicants have argued:

... the referenced '539 patent application was filed over two and one-half years after the present application, so the '539 application cannot be used to determine the mental state of the inventors at the time of filing of the present application. Furthermore, the Examiner has failed to provide any analysis of why the FIG of the '539 application was allegedly the inventors' best mode.

If, as Applicants have argued, "those skilled in the art, such as chemical engineers, would readily recognize both the need for and identity of appropriate pressure controls, such as valves and the like" and, that a "patent need not teach, and preferably omits, what is well known in the art," why then, have Applicants included a disclosure of such means in **11/277,073**? It is submitted that Applicants recognized the deficiency of this disclosure, and attempted to remedy it in **11/277,073**.

Non-Compliant Claims

Several claims are listed using the status identifier "**Canceled**," yet the text also appears. The text of canceled claims should not appear. Any future claim listing should delete the text of these canceled claims.

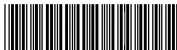
Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication should be directed to /Robert James Popovics/ at telephone number (571) 272-1164.

**/Robert James Popovics/
Primary Examiner
Art Unit 1797**

Search Notes

Application/Control No.

10/663,918

Examiner

Robert James Popovics

Applicants

WILSAK et al.

Art Unit

1797

SEARCHED

Class	Subclass	Date	Examiner
210	767	6-12-06	RJP
	770		
	771		
	772		
	248		

INTERFERENCE SEARCHED

☐ PGPUb search conducted; search logic is attached.

Date: _____ Initials: _____

**SEARCH NOTES
(INCLUDING SEARCH STRATEGY)**

	DATE	EXMR
Text Search Conducted.	6-12-06	RJP
Text Search Conducted.	8-4-08	/RJP/
Text Search Conducted.	12-19-08	/RJP/
Text Search Conducted.	5-5-09	/RJP/